



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2000-0020.00

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on June 30, 2006

Signature

Typed or printed name Ronald K. Aust

Application Number

09/818,179

Filed

March 27, 2001

First Named Inventor

Richard Francis Russell, et al.

Art Unit

2152

Examiner

V. Lesniewski

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 Reg. No. 36,735

Signature

Ronald K. Aust

Typed or printed name

317-894-0801

Telephone number

June 30, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of) Group: 2152
Richard Francis Russell, et al.) Examiner: V. Lesniewski
Serial No.: 09/818,179)
Filed: March 27, 2001)
Title: METHOD OF SHARING A PRINTER) Attorney Docket: 2000-0020.00

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby submit the present Attachment to their Pre-Appeal Brief Request For Review.

REMARKS

Claims 1-23 are pending in the present patent application. Claims 1-23 stand rejected.

Applicants respectfully submit that claims 1-23 are patentable over the cited reference, and that the rejections of claims 1-23 are clearly in error, for at least the reasons set forth below.

Applicants mailed a Request for Continued Examination (RCE) on January 3, 2006, in the present application. Examiner issued a first action final office action, mailed April 3, 2006.

I. Claims 1-10, 12, 17, 18 and 20-23 were rejected under 35 U.S.C. §102(e) as being anticipated by Yamazaki (U.S. Patent No. 6,785,727 B1).

Applicants have summarized Yamazaki as set forth in Applicants' Response (mailed July 15, 2005) to the Office Action of April 15, 2005, beginning at page 3, first full paragraph, and ending after the first full paragraph of page 4, and for brevity will not be repeated here.

In an Amendment Accompanying the RCE, claims 1, 17 and 18 were amended. In particular, each of Applicants' independent claims 1, 17 and 18 were amended to clarify that, in contrast to the time reservation based system of the cited art Yamazaki (U.S. Patent No. 6,785,727 B1, the present invention operates on a "fair-sharing first come first serve basis". "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP 2131.

Claim 1, for example, is directed to a method of sharing a printer between a plurality of users on a computer network. Claim 1 recites, “attaching host-based networking hardware to the printer; providing a network communication protocol defining a command channel and a data channel; allowing only one of the users to own the data channel at any single point in time on a fair-sharing first come first serve basis; and instructing the host-based networking hardware to accept information on the data channel only from the user that owns the data channel.”

It is the Examiner’s position that Yamazaki, column 8, lines 28-34, discloses allowing only one of the users to own the data channel at any single point in time on a fair-sharing first come first serve basis. However, Yamazaki states at column 8, lines 28-34, that, “The start time of a reserved time zone is input to 601 and 602. The end time of the reserved time zone is input to 603 and 604. By pressing the "OK" button of 605, the reserved time is transmitted to an image processor. The reserved time is stored in the timetable 501 in Fig. 5. When the reserved time set here is already reserved by other user, it is necessary to reset a reserved time.” In particular, this passage from Yamazaki makes clear that Yamazaki discloses a time reservation based method, in contrast to the “fair-sharing first come first serve” method of the present invention.

Applicants will illustrate by example the distinction between the Yamazaki time reservation based method and the fair-sharing first come first serve method of the present invention. Yamazaki discloses a method wherein a first user can establish a first reserved block of time, and wherein a second user cannot reserve a time that overlaps the first reserved block of time, notwithstanding that the first user may not actually be using the first block of time in its entirety, if at all (not fair-sharing). However, the second user may be able to reserve a second block of time, even if it is before the first reserved block of time (not first come first serve).

In contrast, with the present invention, no reservations are used. Each potential user has an equal chance (fair-sharing) of capturing the data channel without pre-arranging data channel ownership at a reserved time. For example, with the present invention, if no other user owns the data channel, whichever user makes the request for data channel ownership first (first come first serve) will be granted ownership. If the data channel is currently owned by a user, then another user simply has to wait.

As a second example to illustrate the distinction between the Yamazaki time reservation based method and the fair-sharing first come first serve method of the present invention, consider two restaurants, an up-scale restaurant that takes reservations and a fast food restaurant that does not take reservations. Just as the manner of customer admission in an up-scale restaurant by

reservation is different from that of customer admission at a fast food (first come first serve) restaurant, so is the time reservation based method of Yamazaki different from the fair-sharing first come first serve method of the present invention. The Yamazaki method and the method of claim 1 are different and achieve a different intended result.

In the present invention, there is no ownership of a data channel based on time reservations, but rather, with the present invention data channel ownership is based on fair-sharing of the data channel on a first come first serve basis. As stated in Applicants' specification at page 3, lines 17-19, "Workstation host-based networking print drivers are designed to cooperate in order to facilitate the "fair-sharing" of the host-based networking printer amongst a number of workstations." As further stated at page 5, lines 8-14, "According to the command channel logic, the host-based networking hardware waits for a command signal to do something. If the command is a connect signal, then the printer checks for data channel ownership. If the data channel is not in use, then the sender of the connect signal is recorded as the owner of the data channel and the STATUS response containing the new owner is transmitted to the sender. If, on the other hand, the data channel already has an owner, then the STATUS response containing the current owner is sent to the sender of the connect signal." Thus, the present invention is not time reservation based, as in Yamazaki, but rather, the present invention is time independent and allows only one of the users to own the data channel at any single point in time on a fair-sharing first come first serve basis.

Accordingly, it is respectfully submitted that Yamazaki does not anticipate the claimed subject matter of claim 1, since Yamazaki does not disclose allowing only one of the users to own the data channel at any single point in time on a fair-sharing first come first serve basis, nor does Yamazaki provide any suggestion of the same.

Claims 2-10 and 12 are patentable over Yamazaki in view of their dependence, either directly or indirectly, from claim 1.

Claim 17 is patentable over Yamazaki for substantially the same reasons set forth above with respect to claim 1.

Claim 18, and claims 20-23 dependent therefrom, are patentable over Yamazaki for substantially the same reasons set forth above with respect to claim 1.

In view of the above, it is respectfully requested that the rejection of claims 1-10, 12, 17, 18 and 20-23 under 35 U.S.C. §102(e) as being anticipated by Yamazaki be withdrawn.

II. Claims 11 and 13-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yamazaki. Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Yamazaki in view of Official Notice.

Claims 11 and 13-16 are allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 1 and/or any intervening claim. Claim 19 is allowable due to its dependence on otherwise allowable base claim 18. In addition, claims 11, 13-16, and 19 further and patentably define the invention over Yamazaki.

For example, claim 13 is directed to the method of claim 12, wherein, “in response to receiving said communication frame that does not have said expected sequence number, the host-based networking hardware sends an acknowledgement including the frame number of a last successfully received communication frame to the user that owns the data channel.” (Emphasis added). As previously stated by the Examiner at paragraph 14 from the final office action of October 11, 2005, “the rejection does not rely on Williams et al., which was only cited as being considered pertinent art.” However, in the present final office action with respect to claim 13, the Examiner does not address how the portion of claim 13 underlined above is disclosed, taught or suggested by Yamazaki, other than to say at paragraph 11 that Williams, et al. (U.S. Patent No. 6,202,096) shows a common practice of using acknowledgement, i.e., essentially relying on Official Notice provided by Williams, et al., and thus it would be “obvious... to modify the system of Yamazaki by adding the ability to send acknowledgements” However, since the grounds for rejection is based solely on Yamazaki, as asserted by the Examiner, then it is improper to rely on a modification of Yamazaki based on Williams, as this would be a new grounds for rejection.

Notwithstanding, it is further submitted that the Examiner has not set forth a prima facie case of unpatentability of claim 13 based on Yamazaki modified by Williams, et al., since the Examiner has not shown how the combination of Yamazaki modified by Williams, et al. would yield a method wherein, in response to receiving said communication frame that does not have said expected sequence number, the host-based networking hardware sends an acknowledgement including the frame number of a last successfully received communication frame to the user that owns the data channel, as recited in claim 13. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.

In rejecting claims 14-16, the Examiner references Williams, et al. as disclosing the general concepts of timeouts (i.e., Official Notice), but does not “rely” on Williams, et al. in

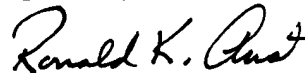
combination with Yamazaki in the rejection of claims 14-16 under 35 U.S.C. §103(a). Yamazaki does not expressly disclose the use of timeouts, as acknowledged by the Examiner, nor does Yamazaki make any implicit disclosure of such. The Examiner asserts that Yamazaki "could easily use a timeout if frames are not received at the printer." (Emphasis added). However, as set forth in MPEP 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990)." (Emphasis added). In the present instance, neither Yamazaki nor Williams, et al. suggests such a desirability, nor is there any suggestion in the references as to how Yamazaki might be modified to yield the claimed invention.

Accordingly, for at least the reasons set forth above, it is respectfully requested that the rejections of claims 11 and 13-16, and claim 19, under 35 U.S.C. §103(a) be withdrawn.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorize that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (317) 894-0801.

Respectfully submitted,



Ronald K. Aust, Attorney for Applicants
Registration No. 36,735

RKA/ts

TAYLOR & AUST, P.C.
12029 E. Washington Street
Indianapolis, IN 46229
Telephone: 317-894-0801
Facsimile: 317-894-0803

Enc.: Return postcard

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: June 30, 2006

Ronald K. Aust, Reg. No. 36,735

Name of Registered Representative



Signature

June 30, 2006

Date